

REMARKS

The final Office Action dated November 28, 2006, and the patents relied on therein have been carefully reviewed, and in view of the above changes and following remarks reconsideration and allowance of all the claims pending in the application are respectfully requested.

Claims 1, 2, 4-11, 14, 15, 18, 21, 23-31 and 34 stand finally rejected. Claim 3 has been previously canceled. Claims 35 and 36 have been allowed. Claims 12, 13, 16, 17, 19, 20, 22, 32 and 33 have been indicated as containing allowable subject matter and would be allowable if rewritten to include all of the limitations of the respective base claims and any intervening claims.

By this Amendment, claims 1, 2, 4-7, 9, 14, 15, 18, 19, 21-25, 28, 30 and 32-34 have been amended. Claims 1, 2 and 4-36 remain pending.

The Amendment To The Claims

Claims 1, 23, 25 and 34 have been amended to more clearly distinguish over the applied art of Herdal. In particular, claim 1 been amended to comprise “at least one item frictionally yet releasably situation in said first cavity” and so that the claimed “first cavity sidewall perimeter surface billows inward toward said first cavity to frictionally yet releasably hold” the claimed at least one item, and so the claimed first cavity sidewall perimeter surface at least partially obscures the claimed first cavity floor surface when the claimed “at least one item is frictionally yet releasably situated in the first cavity”. Each of claims 23, 25 and 34 has been amended similarly. Support for this amendment can be found throughout the specification, for example, at least at lines 1 and 2 of paragraph [028], lines 6-8 of paragraph [072], and Figures 1C, 1G, 2 and 3A of the originally filed patent application.

Additionally, claims 1, 2, 5-7, 14, 15, 18, 19, 21-25, 28, 30 and 32-34 have been amended to improve their respective forms in accordance with U.S. patent law. In particular, Applicants have amended claims 1, 2, 5-7, 14, 15, 18, 19, 21-25, 28, 30 and 32-34 (1) to improve the preamble, (2) to replace the word “including” with the word “comprising”; (3) to replace the word “has” with the word “comprises”; (4) to replace the word “which” with the word “that.”; (5) to replace the word “have” with the word “comprise”; and/or (6) to replace the word “where” with the word “wherein”. Because these amendments are not in response to prior art, are

directed to formal matters, do not narrow the scope of the amended claims and in some cases actually broaden the claim scope, no prosecution-history estoppel results from these amendments.

The Rejection Under 35 U.S.C. § 103(a) Over Herdal In View of Redman

Claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal, U.S. Patent No. 3,175,230, in view of Redman, U.S. Patent No. 4,091,481.

Applicants respectfully traverse this rejection. Applicants respectfully submit that the subject matter according to any of claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34 is patentable over Herdal in view of Redman. Applicants respectfully submit that the applied patents are not properly modifiable or combinable to form a basis for rejection of these claims. Further, the device resulting from the combination of the applied patents is not the claimed subject matter.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (See, also, MPEP §§ 706.02(j) and 2143).

Regarding the first basic criterion for establishing a *prima facie* case of obviousness, Applicants respectfully submit that contrary to the Examiner's assertion, neither Herdal nor Redman disclose or suggest "to employ indicia on the pillow, first door, or first item and alter the outer perimeter as taught by Redman in order to personalize and provide a novelty pillow." In particular, the Examiner admits that "Herdal fails to disclose indicia on the cushioning member, first door, or first item and said cushioning member having an outline that is visually shaped to further indicate said illustrated theme." (See final Office Action dated November 28, 2006,

page 3, lines 17-19.) In this vein, Applicants also respectfully note that Herdal fails to disclose that “at least one of said cushioning member and said first door have indicia, said at least one item and said indicia together visually indicating an illustrated theme.” (See, for example, claim 1 of the present patent application.) As such, it follows that Herdal cannot suggest “indicia on the cushioning member, first door, or first item and said cushioning member having an outline that is visually shaped to further indicate said illustrated theme,” and/or cannot suggest “at least one of said cushioning member and said first door have indicia, said at least one item and said indicia together visually indicating an illustrated theme.” Consequently, if such a motivation or suggestion exists for modifying Herdal or for combining Herdal and Redman, such a motivation or suggestion must be provided by Redman or be in the knowledge generally available to one of ordinary skill in the art.

Considering Redman, the Examiner cites column 1, lines 5-8, as apparently providing such a motivation or suggestion. (See final Office Action dated November 28, 2006, page 3, line 22.) This portion of Redman discloses that “[t]his invention relates to a novelty device of particular interest to children of tooth losing age, and more particularly, to a tooth pillow novelty device for receiving and holding baby teeth and coins.” Applicants respectfully submit that if this portion of Redman is providing the motivation or suggestion that is necessary for first basic criterion for establishing a *prima facie* case of obviousness, it would seem that the Examiner is really asserting that this portion of Redman would motivate or suggest to a person of ordinary skill that the Herdal bolster should be modified to include lost-tooth and/or lost-tooth-reward indicia. If such were the case, Applicants respectfully submit that a person of ordinary skill in the art would accordingly be motivated to attach a pocket 20 to the Herdal bolster such that the pocket would have lost-tooth and/or lost-tooth-reward indicia. But the Examiner does not specifically point out where Redman provides such a motivation or suggestion because Redman does not provide such a motivation or suggestion that lost-tooth and/or lost-tooth-reward indicia could and/or should be attached to a bolster such as that disclosed by Herdal. (Moreover, such a modification would result in not being the claimed subject matter of the present patent application, but such a result relates to the third basic criterion for establishing a *prima facie* case of obviousness). Thus, Applicants respectfully submit that Redman plainly does not provide the Examiner’s proffered motivation or suggestion for modifying Herdal or for combining Herdal and Redman.

Considering the knowledge generally available to one of ordinary skill in the art, Applicants respectfully submit that it is farfetched if the Examiner is suggesting that the knowledge generally available to one of ordinary skill would motivate or suggest that one of ordinary skill in the art would place night-wear indicia on the cushioning member and the door of the Herdal bolster because the night wear is stored inside the Herdal bolster. Applicants are not urging that such an occurrence is impossible. Instead, Applicants are asserting that in this case based on Applicants' disclosure and based on the on-the-record assertions of the Examiner, such a motivation or suggestion is only occurring because of Applicants' disclosure.

Regarding claim 1 and the third basic criterion for establishing a *prima facie* case of obviousness, Applicants respectfully submit that neither Herdal nor Redman disclose or suggest at least one item frictionally yet releasably situated in the claimed first cavity such that the claimed first cavity sidewall perimeter surface billows inward toward the first cavity to frictionally yet releasably hold the claimed at least one item.

The Examiner asserts that Herdal discloses "at least one item removably situated in said first cavity" and relies on column 1, lines 20-22 of Herdal for this assertion. The Examiner then asserts that the first cavity sidewall perimeter surface of Herdal billows inward toward said first cavity and is capable of "snuggly" holding the at least one item.

Applicants respectfully submit that when the complete disclosure of Herdal is considered, it is plain that the Examiner is ignoring the actual disclosure of Herdal and, instead, is using hindsight reconstruction to modify Herdal in order to cause Herdal to "become" the claimed subject matter. More specifically, column 1, lines 7-11, of Herdal discloses that "[t]his invention relates to a bolster for night wear and has as its primary object the provision of an ornamental bolster provided with a relatively rigid frame surrounding a central cavity, in which night wear may be folded and stored." Additionally, column 1, lines 18-22, of Herdal discloses "[a] further object of the invention is the provision of a device of this character having a stiff or relatively firm framework surrounding the cavity so that the night wear contained therein will not become mussed or crumpled when retrieved." Applicants respectfully submit that these two portions of Herdal plainly indicate that a user of a Herdal bolster would have full intentions of folding and storing night wear in the bolster so that the night wear would not be "mussed or crumpled when retrieved." Nevertheless, the Examiner seems to ignore this disclosure and seems to assert that a user of a Herdal bolster would cram their night wear into the bolster so that the night wear is

snuggly held and would not be concerned with the night wear being “mussed or crumpled when retrieved.” Applicants respectfully submit that the Examiner does not even attempt to explain away the fully disclosure of Herdal. Applicants respectfully submit that the only way such a characterization of Herdal is possible is by ignoring the actual disclosure and mischaracterizing Herdal so that Herdal “becomes” the claimed subject matter.

Regarding Redman, Applicants respectfully note that with good reason the Examiner is silent regarding Redman disclosing or suggesting at least one item frictionally yet releasably situated in the claimed first cavity such that the claimed first cavity sidewall perimeter surface billows inward toward the first cavity to frictionally yet releasably hold the claimed at least one item. Plainly, Redman is silent in this regard. Nevertheless, it is possible that the Examiner is finding the concept of “snuggly” holding an item by inference from Redman. If so, Redman would, at best, infer the concept of “snuggly” holding a lost tooth. Applicants respectfully submit that such a modification is completely contrary to the purpose of the Herdal bolster, which is disclosed by Herdal to hold night wear in a manner so the night wear will not become “mussed or crumpled when retrieved.” (Moreover, it is respectfully noted that night wear is significantly larger than a lost tooth.) Accordingly, such an inference is plainly baseless.

Thus, claim 1 is allowable over Herdal in view of Redman. It follows that claims 5-11, 14, 15 and 18, which all incorporate the limitations of claim 1, are each allowable over Herdal in view of Redman for at least the same reasons that claim 1 is considered allowable.

Regarding claim 23, Applicants respectfully submit that claim 23 is allowable over Herdal in view of Redman for reasons that are similar to the reasons that claim 1 is considered allowable. In particular, the first and third basic criteria for establishing a prima facie case of obviousness have not been established for claim 23. Thus, claim 23 is allowable. It follows that claim 24, which incorporates the limitations of claim 23, is allowable over Herdal in view of Redman for at least the same reasons that claim 23 is considered allowable.

Regarding claim 25, Applicants respectfully submit that claim 25 is allowable over Herdal in view of Redman for reasons that are similar to the reasons that claim 1 is considered allowable. In particular, the first and third basic criteria for establishing a prima facie case of obviousness have not been established for claim 25. Thus, claim 25 is allowable. It follows that claims 28-31, which all incorporate the limitations of claim 25, are each allowable over Herdal in view of Redman for at least the same reasons that claim 25 is considered allowable.

Regarding claim 34, Applicants respectfully submit that claim 34 is allowable over Herdal in view of Redman for reasons that are similar to the reasons that claim 1 is considered allowable. In particular, the first and third basic criteria for establishing a prima facie case of obviousness have not been established for claim 34. Thus, claim 34 is allowable.

The Examiner cites *In re Fine*, 837 f.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir 1992) for the proposition of law that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Interestingly, Applicants respectfully note that in both *In re Fine, supra*, and *In re Jones, supra*, the Court of Appeals for the Federal Circuit (CAFC) reversed the decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office affirming the Examiner's final rejection. In particular, in *In re Fine, supra*, the CAFC indicated that there was nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention and that there was no offered support for the conclusion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art." Similarly, in *In re Jones, supra*, the CAFC indicated that there was no evidence in the record that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at Jones' claimed invention.

Applicants respectfully submit that in this particular instance the Examiner has similarly failed to specifically identify a teaching, suggestion or motivation in either Herdal and Redman to combine and/or modify Herdal and Redman to produce the claimed subject matter. Further, Applicants respectfully submit that the Examiner has failed to specifically identify the knowledge generally available to one of ordinary skill in the art without gleaning the knowledge only from the Applicants' disclosure that would support combining and/or modifying Herdal and Redman to produce the claimed subject matter.

The Examiner also cites *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) for the proposition of law that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning and as long as the hindsight reasoning takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from Applicants' disclosure, such a reconstruction is proper. Nevertheless, Applicants respectfully submit that the Examiner has failed to identify what knowledge was within the level of ordinary skill and that the knowledge on which the Examiner relies was not gleaned only from Applicants' disclosure so that the Examiner's admitted hindsight reconstruction would be proper.

Accordingly Applicants respectfully submit that it is only by impermissible hindsight that the Examiner is able to reject claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34 based on the combination of Herdal in view of Redman. Neither of the applied patents provides a proper suggestion for modifying Herdal or for combining Herdal and Redman, and even if these two patents did provide a motivation or suggestion, the device resulting from the combination of Herdal and Redman is simply not the claimed subject matter. Further, the Examiner has not identified a proper motivation or suggestion in the knowledge generally available to one of ordinary skill in the art to modify Herdal or to combine Herdal and Redman. It is only by using Applicants' disclosure as a template that the Examiner is able to select particular features of Herdal and Redman through a hindsight reconstruction of Applicants' claims to make the rejection.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34

**The Rejection Under 35 U.S.C. § 103(a) Over Herdal
In View of Redman And Further In View Of Saarela**

Claims 2 and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal in view of Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28, 29 and 31 and further in view of Saarela et al. (Saarela), U.S. Patent No. 5,788,468.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Saarela does not cure the deficiencies of Herdal and Redman with respect to claims 1 and 25, the respective base claims of claims 2 and 26.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 2 and 26.

**The Rejection Under 35 U.S.C. § 103(a) Over Herdal
In View of Redman And Further In View Of Gervaise**

Claims 4 and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal in view of Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28, 29 and 31 and further in view of Gervaise, U.S. Patent No. 3,378,948.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Gervaise does not cure the deficiencies of Herdal and Redman with respect to claims 1 and 25, the respective base claims of claims 4 and 27.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 4 and 27.

**The Rejection Under 35 U.S.C. § 103(a) Over Herdal
In View of Redman And Further In View Of Gervaise**

Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal in view of Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28, 29 and 31 and further in view of Perez-Mesa et al. (Perez-Mesa), U.S. Patent No. 6,105,188.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Perez-Mesa does not cure the deficiencies of Herdal and Redman with respect to claim 1, the base claim of claim 21.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claim 21.

Allowable Subject Matter

Applicants respectfully acknowledge that the Examiner has indicated that claims 35 and 36 have been allowed, and that claims 12, 13, 16, 17 19, 20, 22, 32 and 33 have been indicated as containing allowable subject matter and would be allowable if rewritten to include all of the limitations of the respective base claims and any intervening claims. Applicants respectfully submit that this subject matter should still be allowable.

Applicants note that additional patentable distinctions between Herdal, Redman, Saarela, Gervaise, Perez-Mesa and the rejected claims exist; however, the foregoing is believed sufficient

to address the Examiner's rejections. Additionally, failure of Applicants to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Applicants do not agree.

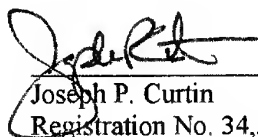
CONCLUSION

In view of the above amendments and arguments, it is urged that the present application is now in condition for allowance. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

It is requested that this application be passed to issue with claims 1, 2 and 4-36.

Respectfully submitted,

Date: November 9, 2007

A handwritten signature in black ink, appearing to read "J. P. Curtin", is written over a horizontal line.

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